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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,257	02/13/2006	Jung-Keun Kim	1222003USA	9671

JHK Law
P.O. Box 1078
La Canada, CA 91012-1078

7590

07/13/2007

EXAMINER

ISSAC, ROY P

ART UNIT	PAPER NUMBER
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1623

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/568,257

Applicant(s)

KIM ET AL.

Examiner

Roy P. Issac

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-12 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

This application is a 371 of PCT/KR04/02255 filed 09/06/2004 and claims priority to foreign application KOREA 10-2003-0062418 filed 09/06/2003. Certified copy of the foreign application in Korean is received. No translation is received.

This Office Action is in response to Applicant's amendment/ remarks/ response filed 05/08/2007, wherein all pending claims have been cancelled and claims 6-12 were newly submitted.

Newly submitted claims 6 and 12 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 6 and 12 are directed to a method of treating arthritis with an extract of Notoginseng radix extract while the originally claimed invention was directed to a composition comprising Notoginseng radix extract. Inventions of claims 6 and 12, and the claims 7-11 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the process for treating arthritis can be practiced using one of the several well known pain medications including aspirin, advil etc.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 6 and 12 are withdrawn from

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consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Rejections Withdrawn

In view of the cancellation of claims 1-5, all rejections and objections made with respect to claims 1-5 in the previous office action are withdrawn.

The following are new rejections necessitated by the submission of new claims 6-12:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recitation "butanol fraction of

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Lin et. al. (CN 14188690A; Derwent Abstract; Of record).

Lin et. al. discloses an extract of the root of *Notoginseng*. The extraction is prepared by ethyl alcohol and used for tablets and capsules. The recitations, "for preventing and treating arthritis", and "health food composition" are considered intended use of the extract. Note that it is well settled that "intended use" of a composition or product, e.g., "treating arthritis", will not further limit claims drawn to a composition or product, so long as the prior art discloses the same composition comprising the same ingredients in an effective amount, as the instantly claimed. See, e.g., *Ex parte Masham*, 2 USPQ2d 1647 (1987) and *In re Hack* 114, USPQ 161. As such, claims 1-5 are anticipated by Lin et. al. Note that , the "butanol fraction of extract of *Notoginseng radix* extracted by water, ethanol or mixed solvent of water and ethanol", is considered to be part of the ethanol extract of Lin et. al. Since the claims herein use the open transitional phrase and does not exclude all else in the ethanol extract, the butanol fraction is considered part of the ethanol extract composition.

Claims 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Cui et. al. (CN 1348796A; Derwent Abstract; Of Record).

Cui et. al. discloses a medicinal composition for treating ache comprising extract of *radix notoginseng*. The extraction was performed by ethyl alcohol. As noted above, the recitations, "for preventing and treating arthritis", and "health food composition" are

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considered intended use of the extract. As such, claims 1-5 are anticipated by Cui et. al. Note that , the "butanol fraction of extract of *Notoginseng radix* extracted by water, ethanol or mixed solvent of water and ethanol", is considered to be part of the ethanol extract of Lin et. al. Since the claims herein use the open transitional phrase and does not exclude all else in the ethanol extract, the butanol fraction is considered part of the ethanol extract composition.

Claims 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Liu et. al. (U.S. Patent NO. 4,755,504; Of Record).

Liu et. al. discloses a pharmaceutical compositions containing saponin and quercetin derived from Tienchi for the treatment of circulatory disease and as health food. The ingredients are derived rom the root Tienchi. Tienchi is the Chinese name for Panax Notoginseng. (Column 1, lines 12-19). A method for extracting Tienchi roots (radix) using ethanol is disclosed. (Example 1, Column 3). . As noted above, the recitations, "for preventing and treating arthritis", and "health food composition" are considered intended use of the extract. Note that , the "butanol fraction of extract of *Notoginseng radix* extracted by water, ethanol or mixed solvent of water and ethanol", is considered to be part of the ethanol extract of Lin et. al. Since the claims herein use the open transitional phrase and does not exclude all else in the ethanol extract, the butanol fraction is considered part of the ethanol extract composition. As such, claims 7-11 are anticipated by Liu et. al.

Conclusion

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy P. Issac whose telephone number is 571-272-2674. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia Anna Jiang can be reached on 571-272-0627. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Roy P. Issac
Patent Examiner
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A handwritten signature in black ink, appearing to read 'S. Anna Jiang' with a date '7/14/07' written below it.

S. Anna Jiang, Ph.D.
Supervisory Patent Examiner
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